No. 18-302

In the Supreme Court of the United States

ANDREI IANCU, UNDER SECRETARY OF COMMERCE FOR INTELLECTUAL PROPERTY AND DIRECTOR, UNITED STATES PATENT AND TRADEMARK OFFICE,

Petitioner,

v.

ERIK BRUNETTI,

Respondent.

On Writ of Certiorari to the United States Court of Appeals for the Federal Circuit

BRIEF OF AMICUS CURIAE SIMON TAM IN SUPPORT OF RESPONDENT

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INTEREST OF AMICUS CURIAE[1]

Amicus Simon Tam is a musician, lecturer, and political activist. He is the founder of The Slants Foundation, a nonprofit organization dedicated to supporting the work of artists-activists. Tam was the respondent in *Matal v. Tam*, 137 S. Ct. 1744 (2017), thanks to which the name of his band—The Slants—is now a registered trademark. He has an interest in supporting the civil rights of members of marginalized communities, many of whom, like Tam, use trademarks as a means of expression.

SUMMARY OF ARGUMENT

The ban on registering "immoral" or "scandalous" trademarks is a relic of the Victorian era, when judges and other government officials were often enlisted to scrub public discourse of anything that might offend the most prudish sensibilities. Like the copyright law (which at the time also denied protection to ostensibly immoral works), the Comstock laws, and the early film censorship schemes, the ban on registering immoral trademarks was part of a world in which the government routinely restricted speech that government officials deemed to be immoral.

Needless to say, that world is long gone. We recognized long ago that Americans hold extremely diverse views of what is moral and what is not, and

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[1] No counsel for a party authored this brief in whole or in part, and no person other than amicus and his counsel made a monetary contribution intended to fund the preparation or submission of this brief. The parties have consented to the filing of this amicus brief.

that government officials have no business restricting non-obscene speech to enforce one view of morality over another. Today, the "immoral ... or scandalous" clause of the Lanham Act is a holdover from another age.

ARGUMENT

The ban on registering immoral trademarks is the last vestige of a Victorian legal culture in which government officials routinely restricted speech to promote morality.

Before the enactment of the Trademark Act of 1905, trademarks were governed by common law, under which an immoral mark was ineligible for protection. As one of the earliest American trademark treatises observed, "[t]o be a 'lawful trade-mark' the emblem must not transgress the rules of morality." William Henry Browne, *A Treatise on the Law of Trade-Marks* 465 (1873). This ban on immoral trademarks was incorporated in the Trademark Act of 1905, which required the Patent Office (as it was then called) to refuse registration to any mark that "[c]onsists of or comprises immoral or scandalous matter." Pub. L. No. 58-84, § 5(a), 33 Stat. 724, 725 (1905). *See* Harry D. Nims, *The Law of Unfair Competition and Trade-Marks* 384 (2d ed. 1917) ("The provision of the United States statute excluding from registration marks that are scandalous or immoral

in their purport, corresponds to the common-law rule.").[2]

At the time, there were many other areas of the law in which judges and other government officials were likewise enlisted to purge immorality from public discourse. In these other areas, however, public officials are no longer called upon to perform this role. Today, the prohibition on registering immoral trademarks stands as an anachronistic remnant of an era that vanished long ago.

A. When Congress banned the registration of immoral trademarks, there were many other areas of law in which judges and other officials restricted speech they considered immoral.

Trademark law circa 1905 was typical of the era's law in restricting speech to promote morality. We will discuss three examples: copyright, the Comstock laws, and film censorship.

1. Copyright

The most obvious analogue to trademark law was copyright law, which likewise denied protection to expression a court deemed immoral. *See, e.g.*, Easton S. Drone, *A Treatise on the Law of Property in Intellectual Productions* 185 (1879) ("The protection of the [copyright] law will not be extended to a publication which is obscene, or has a positive immoral tendency."); Joseph Story, *Commentaries on Equity Ju-*

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[2] The PTO has long treated "immoral" and "scandalous" as synonyms, so we will do the same. *Cf.* Gov't Br. 6 (also treating the two terms as synonyms).

risprudence 2:124 (Isaac F. Redfield ed., 10th ed. 1870) ("no copyright can exist, consistently with principles of public policy, in any work of a clearly irreligious, immoral, libellous, or obscene description").

For example, when the owner of a copyrighted play called "The Black Crook" sued an infringer who presented a nearly identical play called "The Black Rook," the court refused to enforce the copyright because the judge believed "The Black Crook" was immoral. "The principal part and attraction of the spectacle seems to be the exhibition of women in novel dress or no dress," he complained. *Martinetti v. Maguire*, 16 F. Cas. 920, 922 (C.C.D. Cal. 1867). "[T]he benefit of copyright is a privilege conferred by congress," the court declared. "In conferring this privilege or monopoly upon authors and inventors, I suppose that it is both proper and constitutional for congress so to legislate, as to encourage virtue and discourage immorality." *Id.*

Similarly, in a suit alleging the infringement of a copyrighted song entitled "Dora Dean," the court would not enforce the copyright because the song included this line: "She's the hottest thing you ever seen." *Broder v. Zeno Mauvais Music Co.*, 88 F. 74, 78 (C.C.N.D. Cal. 1898). The court reasoned: "It is difficult to escape the conclusion that the word 'hottest,' as used in the song 'Dora Dean,' has an immoral signification." *Id.* at 79. The court concluded that the word "has an indelicate and vulgar meaning, and that for that reason the song cannot be protected by copyright." *Id.*

Another court denied copyright protection to a combined stage and film performance portraying "a

human being in nude or seminude conditions making quick changes of dress or costume," on the ground that it was "lascivious and immoral." *Barnes v. Miner*, 122 F. 480, 489 (C.C.S.D.N.Y. 1903). The performance was not "of a nature calculated to elevate, cultivate, inform, or improve the moral or intellectual natures of the audience," the court insisted. *Id.* Because it depicted "domestic infelicity and marital infidelity and gross immorality," it was not entitled to copyright. *Id.*

In such cases, courts earnestly believed they had a duty to shield the public from immoral speech. "The rights of the author are secondary to the right of the public, to be protected from what is subversive of good morals," one court declared. *Shook v. Daly*, 49 How. Pr. 366, 368 (N.Y. Ct. Comm. Pleas 1875). Courts thus refused "to vindicate the claims of any party to the exclusive enjoyment or disposal of an immoral or licentious production." *Keene v. Kimball*, 82 Mass. 545, 549 (1860). It was well established during the era that "[t]o be entitled to be copyrighted, the composition must be original, meritorious, and free from illegality or immorality." *Hoffman v. Le Traunik*, 209 F. 375, 379 (N.D.N.Y. 1913) (internal quotation marks omitted).

It has been a very long time since copyright law was used to police morality. By the 1970s, such decisions had long been deemed "vestiges of a bygone era." *Mitchell Bros. Film Grp. v. Cinema Adult Theater*, 604 F.2d 852, 861 (5th Cir. 1979). "[I]t is inappropriate for a court," the Fifth Circuit concluded, to use copyright law "to interpose its moral views between an author and his willing audience." *Id.* In stark contrast to the prim censoriousness of the Vic-

torians, we have come to recognize the wisdom of Justice Holmes's remark that it is "a dangerous undertaking for persons trained only to the law to constitute themselves final judges of the worth of pictorial illustrations" or indeed any other form of expression. *Bleistein v. Donaldson Lithographing Co.*, 188 U.S. 239, 251 (1903).

2. The Comstock laws

When the ban on registering immoral trademarks was enacted, the state and federal governments were engaged in a similar effort to purge immoral materials from the marketplace and the mail. Under what were colloquially known as the Comstock laws (in honor of Anthony Comstock, their enthusiastic proponent), Congress prohibited the exhibition and sale of any "article of an immoral nature," 17 Stat. 598 (1873), and barred from the mail every "publication of a vulgar or indecent character," 17 Stat. 302 (1872). *See* Amy Werbel, *Lust on Trial: Censorship and the Rise of American Obscenity in the Age of Anthony Comstock* (2018).

In one typical case, the early libertarian Ezra Heywood was convicted and sentenced to two years in prison for publishing a short pamphlet called "Cupid's Yokes," in which he argued that marriage should be abolished. David M. Rabban, *Free Speech in Its Forgotten Years* 32-38 (1997). The pamphlet consisted entirely of policy arguments and could not have been thought, even then, to appeal to anyone's prurient interest. (The most heated passage is one in which Heywood calls Comstock "*a religious monomaniac*" who has contrived "to use the Federal Courts to suppress free inquiry." E.H. Heywood, *Cu-*

pid's Yokes 12 (1876).) The court nevertheless concluded that Heywood's pamphlet was "offensive to decency" and capable of causing "thoughts of an immoral tendency." *United States v. Bennett*, 24 F. Cas. 1093, 1104 (C.C.S.D.N.Y. 1879).

Similar cases were common during the period. In New York, a store clerk was convicted of selling photographs of paintings from the Salon in Paris and the Centennial Exhibition in Philadelphia, paintings that depicted nude women. The fact that experts considered the paintings fine art made no difference, in the view of the state Court of Appeals, because the images might "deprave or corrupt those whose minds are open to such immoral influences." *People v. Muller*, 96 N.Y. 408, 411 (1884). A St. Louis physician was convicted of placing in the mail his treatise on venereal disease, because, as the trial court charged the jury, the treatise included "immodest and indecent matter." *United States v. Clarke*, 38 F. 732, 733 (E.D. Mo. 1889). Even those who wrote sealed personal letters were prosecuted, on the theory that the purpose of the Comstock laws was "to purify the mails by stopping the dissemination of immoral and debasing matter" regardless of whether anyone but the addressee would read it. *United States v. Britton*, 17 F. 731, 732 (S.D. Ohio 1883).

Such opinions seem comically puritanical today, because our world is so different from the one inhabited by the judges and legislators of the era. In the late 19th and early 20th centuries, however, the managers of the legal system were committed to purifying discourse of all kinds, including trademarks.

3. Film censorship

As Americans began watching movies around the turn of the 20th century, judges and legislators placed great importance on preventing the public from seeing any immorality on the screen. *See* Lawrence M. Friedman, *Human Rights, Freedom of Expression, and the Rise of the Silver Screen*, 43 Hofstra L. Rev. 1 (2014). Many states and cities established censorship regimes that required a government official to approve a film as moral before it could be exhibited. *See, e.g.*, *Mutual Film Corp. v. Industrial Comm'n*, 236 U.S. 230, 240 (1915) (upholding an Ohio statute allowing the screening of "[o]nly such films as are, in the judgment and discretion of the board of censors, of a moral, educational, or amusing and harmless character").

In 1907, for example, Chicago enacted an ordinance prohibiting the exhibition of "immoral pictures." *Block v. City of Chicago*, 87 N.E. 1011, 1012 (Ill. 1909). Under this ordinance, the city banned the showing of a 1908 film called "The James Boys," which depicted the career of the outlaw Jesse James and his gang, who had committed a series of celebrated robberies approximately forty years earlier. "It is true that pictures representing the career of the 'James Boys' illustrate experiences connected with the history of the country," the Illinois Supreme Court acknowledged in upholding the ban—"but it does not follow that they are not immoral." *Id.* at 1016. The court reasoned that "[p]ictures which attempt to exhibit that career necessarily portray exhibitions of crime." *Id.* The court concluded of "The James Boys," along with another banned film: "They are both immoral, and their exhibition would neces-

sarily be attended with evil effects upon youthful spectators." *Id.*

A few years later, New York barred the exhibition of a film depicting the life of the birth control advocate Margaret Sanger, because the city official responsible for censoring films determined "that in his judgment the film tends to teach immorality." *Message Photo-Play Co. v. Bell*, 166 N.Y.S. 338, 341 (N.Y. App. Div. 1917). When the ban was challenged, the court had little doubt that "the action of the commissioner is justified, both in the interests of public decency and public welfare," because watching the film might cause audience members to develop an interest in using birth control. *Id.* at 344. "[I]t fairly appears," the court worried, "that the concentration of the minds of those in attendance at such a production on this question of birth control for a considerable period of time—for the film is long—may engender a desire to obtain the information, of the existence of which they are thus assured." *Id.*

These film censorship regimes were held unconstitutional long ago. *See, e.g., Joseph Burstyn, Inc. v. Wilson*, 343 U.S. 495 (1952); *Hallmark Prods., Inc. v. Carroll*, 121 A.2d 584 (Pa. 1956); *see generally* Samantha Barbas, *How the Movies Became Speech*, 64 Rutgers L. Rev. 665 (2012). But they were just getting off the ground in 1905, when Congress prohibited the registration of immoral trademarks. At the time, regulators and courts vigilantly policed speech of all kinds in order to prevent any sort of immorality from reaching the public.

B. The Lanham Act's "immoral ... or scandalous" clause is the last remnant of federal law authorizing the restriction of immoral but non-obscene speech.

There appear to be only two other federal statutes that, like the Lanham Act, still include text facially authorizing government officials to restrict speech for being immoral. These are the statutes governing obscenity. On their face, these statutes purport to govern *immoral* speech as well as *obscene* speech. 18 U.S.C. § 1461 bars obscene matter from the mail, as well as "[e]very paper, writing, advertisement, or representation ... for any indecent or immoral purpose." 18 U.S.C. § 1465 prohibits the production and transportation of obscene material, as well as "any other matter of indecent or immoral character."

In these two statutes, however, the "immoral" provisions have long been interpreted to be coextensive with the ban on obscenity. That is, for many years it has been the case that speech cannot be restricted as immoral if it is not obscene. *See, e.g.*, *United States v. 31 Photographs*, 156 F. Supp. 350, 352 n.2 (S.D.N.Y. 1957) ("I do not believe that the word 'immoral' adds to the class of material excluded from importation by the word 'obscene,' and the Government has not contended that it does."); *see also Manual Enters., Inc. v. Day*, 370 U.S. 478, 482-84 (1962) (lead opinion); *United States v. 12 200-Ft. Reels of Super 8MM. Film*, 413 U.S. 123, 130 n.7 (1973); *Hamling v. United States*, 418 U.S. 87, 112-14 (1974).

This narrowing construction has been necessary because the Court has made clear that while obscenity is unprotected by the First Amendment, speech

that is not obscene *is* protected even if some consider it immoral. "[W]here obscenity is not involved, we have consistently held that the fact that protected speech may be offensive to some does not justify its suppression." *Carey v. Population Servs., Int'l*, 431 U.S. 678, 701 (1977); *see also Roth v. United States*, 354 U.S. 476 (1957); *Miller v. California*, 413 U.S. 15 (1973). It has been well established for more than half a century that expression "should not be suppressed merely because it offends the moral code of the censor." *Roth*, 354 U.S. at 513 (Douglas, J., dissenting).

The Lanham Act thus appears to be the only surviving federal statute ostensibly authorizing the restriction of speech for being immoral but not obscene. When Congress enacted this provision in 1905, examples of such regulation were commonplace. Today, the "immoral ... or scandalous" clause of the Lanham Act is the last one standing.

C. The only interest advanced by the ban on registering immoral trademarks is the now-impermissible Victorian aim of insulating the public from offensive speech.

The government's brief demonstrates all too clearly that the only interest advanced by the "immoral ... or scandalous" clause is that of preventing members of the public from being offended by speech they consider immoral. The government offers a few different euphemisms for this interest: "protecting the sensibilities of the public," Gov't Br. 32; "encouraging the use of trademarks that are appropriate for all audiences," Gov't Br. 33; and preventing members of the public from viewing material they find "shocking

to the sense of propriety," Gov't Br. 34 (internal quotation marks and ellipsis omitted). These all mean the same thing—restricting speech that might offend some people because they find it immoral.

In 1905, when this provision was enacted, the First Amendment was an infrequent basis for litigation. First Amendment doctrine barely existed. The government routinely restricted speech on the ground that it might offend some people's sense of morality.

Today, by contrast, it is a staple of First Amendment jurisprudence that speech may not be restricted for the purpose of preventing listeners from being offended. *See Matal v. Tam*, 137 S. Ct. 1744, 1764 (2017) (lead opinion) (rejecting the notion that "[t]he Government has an interest in preventing speech expressing ideas that offend"); *Snyder v. Phelps*, 562 U.S. 443, 458 (2011) ("[S]peech cannot be restricted simply because it is upsetting."); *Forsyth Cty. v. Nationalist Movement*, 505 U.S. 123, 134-35 (1992) ("Speech cannot be financially burdened, any more than it can be punished or banned, simply because it might offend."); *Texas v. Johnson*, 491 U.S. 397, 414 (1989) ("If there is a bedrock principle underlying the First Amendment, it is that the government may not prohibit the expression of an idea simply because society finds the idea itself offensive or disagreeable.").

The government's proffered interest is thus just as anachronistic as the "immoral ... or scandalous" clause itself. It would have been a good argument in 1905, but it hasn't been for a very long time.

CONCLUSION

The judgment of the U.S. Court of Appeals for the Federal Circuit should be affirmed.

Respectfully submitted,

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